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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,009	03/01/2004	Uwe Hermann Goldbeck	81736/LPK	6881
7590	02/09/2005		EXAMINER	
Lawrence P. Kessler NexPress Solutions LLC Patent Department 1447 St. Paul Street Rochester, NY 14653-7103			MORRISON, THOMAS A	
			ART UNIT	PAPER NUMBER
			3653	
DATE MAILED: 02/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/789,009	GOLDBECK, UWE HERMANN
	Examiner	Art Unit
	Thomas A. Morrison	3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 3.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/01/2004.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recited retaining component is assigned to each of said jaw-shaped receivers, in claim 8, must be shown or the feature(s) canceled from the claim(s). Also, the recited two or more conveying components that are separated from one another coaxially, in claim 12, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: (1) lines 5-18 on page 1 of the specification of the instant application appear to be directed to a cross-referenced patent application, but no application number is included in this section of the specification; and (2) "for 7" in line 7 on page 6 should be -- 7 for --.

Appropriate correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Correction of the following is required:

(1) the specification fails to provide proper antecedent basis for the recited length of said slot incorporates sufficient clearance for the leading edge of a sheet-shaped element so that there is no danger that such leading edge will bump against the face of the slot of claim 10; and (2) the specification fails to provide proper antecedent basis for the recited fragmentarily present bending mandrel of claim 1.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form

PTO-892, they have not been considered. In particular, the specification of the instant application refers to German patent No. DE19904853, but this reference was not included in the Information Disclosure Statement of March 1, 2004.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Regarding claims 1-13, the claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Also, claim 1 recites the limitation "the leading edge area" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim. Moreover, it is unclear in claim 1 what is meant by the recited "fragmentarily present bending mandrel". Moreover, it is unclear what constitutes a "sheet-shaped element". In addition, it is unclear which element is referred to by the recited "its" in line 9 of claim 1. Finally, it is unclear what is meant by the recited "in particular" in claim 1.

Regarding claim 2, this claim recites the limitation "the conveying component's direction of rotation" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 3, this claim recites "the other relative positions of rotation" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 6, it is unclear what element the recited "it" in line 4 is referring to.

Regarding claim 10, this claim recites the limitation "the face" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 and 6-13, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by PCT Publication No. WO 94/19268 (cited in applicant's IDS of 03/01/2004).

Regarding the independent claim 1, Figs. 1-4 of PCT Publication No. WO 94/19268 show an apparatus for conveying an essentially sheet-shaped element (1), in particular, for conveying a sheet of printing medium (1) in a printing machine, comprising: at least one rotating conveying component (including 19 and 6) that conveys a sheet-shaped element (1) from a pickup point (21) to a stacking point (17) where it stacks such sheet-shaped element (1), at least one jaw-shaped receiver (6) for the purpose of holding and carrying along the sheet-shaped element (1), for introducing and inserting the leading edge area (near 15) of the sheet-shaped element (1), such at least one jaw-shaped receiver (6) having at least one fragmentarily present bending mandrel for bending the sheet-shaped element (1) around its rotational radius (Fig. 1 shows the bent sheet-shaped element (1) while it is being conveyed, and at least one

retaining component (including 23, 8 and 11) respectively in the area of the at least jaw-shaped receiver (6).

Regarding the dependent claim 2, Fig. 3 shows that the retaining component (including 23, 8 and 10) is essentially a retaining rod (11) that rotates along with the conveying component (including 19 and 6) and can be moved in a direction that is radial to the conveying component's direction of rotation.

Regarding the dependent claim 3, Figs. 1-3 show that the retaining component (including 23, 8 and 10) is moved by an actuating component including an eccentric (7) that is stationary in relation to the conveying component (including 19 and 6) and the retaining component (including 23, 8 and 10), such that the eccentric (7) in at least one relative position of the conveying component's rotation essentially closes the jaw-shaped receiver (6) by such retaining component (including 23, 8 and 10) and, in at least one of the other relative positions of rotation, essentially leaves the jaw-shaped receiver (6) open. See Fig. 1 for operation of jaw-shaped receiver.

Regarding the dependent claim 4, Fig. 1 shows that the eccentric (7) is a cam disk that is aligned next to the conveying component (including 19 and 6).

Regarding the dependent claim 6, Fig. 3 shows that the retaining rod (11) is essentially a piston rod extending radially in relation to the conveying component (including 19 and 6), and is located in a radially-oriented guide slot (i.e., the dotted lines in Fig. 3) in the conveying component (including 19 and 6) where it can move back and forth, whereby an end of the retaining rod (11) that faces away from the jaw-shaped

receiver (6) runs along the eccentric cam disk (7) when the conveying component (including 19 and 6) is rotating.

Regarding the dependent claim 7, Fig. 1 shows that the conveying component (including 19 and 6) is essentially in the shape of a disk.

Regarding the dependent claim 8, Fig. 1 shows two or more jaw-shaped receivers (6) that are equally aligned around a full 360 degrees and that a retaining component (including 23, 8 and 11) is assigned to each of the jaw-shaped receivers (6).

Regarding the dependent claim 9. Figs. 1 and 3 show that the at least one jaw-shaped receiver (6) is essentially a slot or slit.

Regarding the dependent claim 10, Fig. 1 shows that the length of the slot (near 6) incorporates sufficient clearance for the leading edge of a sheet-shaped element (1) so that there is no danger that such leading edge will bump against the face of the slot (near 6). The face of the slot is assumed to be where the jaw-shaped receiver 6 meets with the rest of the conveying component.

Regarding the dependent claim 11, Fig. 1 shows that, wherein, in the area of the stacking point (17), an arresting bar (22) is provided, for the leading edge of the sheet-shaped element (1) that is inserted in the jaw-shaped receiver (6) and, is aligned stationary across from the conveying component (including 19 and 6).

Regarding the dependent claim 12, Fig. 2 shows two or more conveying components (18 and 18) that are separated from one another coaxially (along axis 14).

Regarding the dependent claim 13, Fig. 2 shows that the two conveying components (18 and 18) are aligned in mirror image relative to a reflective plane that is perpendicular to the rotational axis (14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Publication No. WO 94/19268 as applied to claim 4 above, and further in view of Shepherd and Milmoe.

Fig. 2 of PCT Publication No. WO 94/19268 show a cam disk (7, 13) and a drive shaft (14) that rotates coaxially, but does not specifically disclose a stationary axle or a hollow shaft as claimed.

The Shepherd patent discloses that it is well known to provide a sheet handling apparatus with a cam member (102) resting on an axle (104) that is stationary with respect to the cam member (102) with the axle (104) spaced from a drive shaft (34) to allow the cam member (102) to rotate freely relative to the drive shaft (34). In other words, Shepherd discloses a stationary axle (104) on which the drive shaft (34) rotates coaxially. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the apparatus of PCT Publication No. WO 94/19268 with a stationary axle (a bushing) between the cam (7, 13) of PCT Publication No. WO

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94/19268 and the drive shaft, in order to better facilitate free rotation between the cam and the drive shaft, as taught by Shepherd. See column 4, lines 14-33 and Fig. 2-4.

The PCT Publication No. WO 94/19268 and the Shepard patent both show drive shafts, but do not specifically show hollow drive shafts.

The Milmoe patent discloses that it is well known to provide a sheet handling apparatus with a hollow drive shaft (37 or 38). It would have been obvious to one of ordinary skill in the art at the time of the invention, to replace the drive shaft of PCT Publication No. WO 94/19268 with a hollow drive shaft, as this merely involves replacing one well known drive shaft with another well known drive shaft and the hollow drive shaft provides the benefit of reduced weight and reduced inertia.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is 703-305-0554. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600